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OFFICE OF PETITIONS

**Lerner, David, Littenberg,
Krumholz & Mentlik
600 South Avenue West
Westfield, NJ 07090**

In re Application of :
Xian-Ming Zeng :
Application No. 10/646,361 : DECISION ON PETITION
Filed: August 21, 2003 :
Attorney Docket No. TEVNHC 3.0-587 :
:

This is a decision on the petition, filed July 20, 2009, under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application which was filed concurrently with a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application.

The petition under 37 CFR 1.181 is **DISMISSED**.

The Office action rejection mailed February 22, 2008 clearly indicated on page 5 “**THIS ACTION IS FINAL**” although the cover sheet, PTOL-326 indicated “this action is non-final.”

Applicant’s response was an amendment under 37 CFR 1.116 (the rule covering amendments filed after final action) filed on May 23, 2008. Since the amendment was filed under 37 CFR 1.116, applicant considered the Office action of February 22, 2008 to be a final rejection. This amendment did not question the finality of the action nor did it query the apparent inconsistency of the action itself and the cover sheet. Applicant then filed a Notice of Appeal on August 22, 2008 and the application went abandoned for failure to file an appeal brief. A Notice of Abandonment was mailed June 25, 2009. The petition indicates that applicant contacted the art unit SPE on March 20, 2009 and the SPE indicated that the February, 22, 2008 action was not, in fact, final. The record shows no interview summary confirming this point and the Office issued no supplemental Office action clarifying the status of the finality of the February 2, 2008 action. The record also shows that the claims were twice rejected and that applicant was within his rights to appeal the rejection whether or not the Office action was final.

Petitioner provides a copy of a Request for Withdrawal of Notice of Appeal and Refund of Appeal and Extension Fees with a return post card stamped March 23, 2009 (for reasons unknown this paper was never made part of the application). This paper was not acted upon and MPEP 1215.01 indicates that a request for withdrawal of appeal with no allowable claims is treated as an express abandonment. The petition suggests express abandonment was not what applicant desired. The Notice of Appeal was properly filed and the notice *per se* cannot be withdrawn. The application was properly abandoned for failure to file an appeal brief in a timely manner.

For the reasons listed above, the petition to withdraw the holding of abandonment is dismissed.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed August 22, 2008, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 41.37(b). As no claim was allowed, the application became abandoned on October 23, 2008. See MPEP 1215.04. A Notice of Abandonment was mailed June 25, 2009.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (1).

As to item (1) a Notice of Appeal was filed on August 22, 2008 and no reply has been received.

As authorized petitioner's deposit account will be charged \$1,620.00 for the petition fee.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300**.

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.



Carl Friedman
Petitions Examiner
Office of Petitions